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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,572	01/04/2001	Lincoln M. Little	29766-68065	2878
30450	7590	04/21/2005		
CUMMINS, INC. 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			EXAMINER SIMITOSKI, MICHAEL J	
			ART UNIT 2134	PAPER NUMBER

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/754,572

Applicant(s)

LITTLE ET AL.

Examiner

Michael J. Simitoski

Art Unit

2134

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's response (p. 2, ¶3 - p. 5, ¶2) generally asserts that Baker discloses downloading software from support equipment, but no mention is made of security. Further, Applicant asserts that Borgelt shows enabling software that is already resident on the embedded system. The rejections of 6/18/04 and 2/2/05 recite a similar finding. The Examiner's comments regarding Applicant's assertion that claim 1 "requires the software ID to relate to software information that is not resident within the embedded system, but is instead resident within some other system" were made to bring Applicant's attention to the fact that the wording used by Applicant is not in the claims. While the claims may imply generally that the software information is at least partly resident on some other system, as the Examiner has stated in the previous Office Action, the language used by Applicant is not in claim 1 (for example "not resident" and "resident in some other system"). If Applicant intends to rely on this particular claim language, the language must appear in the claims.

Applicant's response (p. 5) recites for both claims 1 & 16 that the remaining references of record, either alone or in combination, likewise fail to teach or suggest basing a software code or ID that forms part of a password on any software program other than a pre-existing software program embedded within the system that will execute such a software program. The Examiner disagrees for at least the reasons given in the following sections.

The following quotation appears in the rejection (final rejection, pp. 4-5) of claim 1:

"As modified, Baker lacks using the authentication, as taught by Borgelt, to download the authorized software based on said password. However, Wells teaches that it is useful to identify a device or its components to guard against inadvertent or intentional modifications (col. 12, lines 28-33) using a system identifier associated with the embedded system/gaming device (col. 11, lines 1-6). Wells teaches that a service/recalibration tool (such as a mobile laptop) can be connected to an embedded system/device to receive a software update (such as a gaming machine) (col. 11, lines 7-10). The laptop can access the gaming devices identifications to determine if it is authorized for a software update (for many reasons, including warranty) (col. 11, lines 1-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the password to enable downloading of the software information. One of ordinary skill in the art would have been motivated to perform such a modification to identify a device or its components to guard against inadvertent or intentional modifications, possibly to avoid updating software on a machine whose warranty has run out, as taught by Wells (col. 11, lines 1-47 & col. 12, lines 28-33)."

Similar application of the Wells reference appears in the rejection of claim 16. It is noted that Applicant has not responded to the Wells reference. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As stated in the rejections of record, Wells teach that it is beneficial to one of ordinary skill in the art to authenticate a terminal which is to receive a software update. In columns 11-12, Wells describes this as important because one can determine whether the terminal is covered by a warranty (i.e. determining whether the terminal has the rights to receive the update) and to prevent intentional or inadvertent modifications to the terminal (requiring that the support equipment authenticate the terminal before giving it an updated software) (col. 11, lines 1-7, 16-17, 35-47 & col. 12, lines 28-54). Wells even teaches that it would be possible to use cryptography to identify the software to be downloaded to ensure that it is appropriate (col. 11, lines 22-34). In Borgelt, a more secure authentication is being performed using cryptography and specifically using a software ID and hardware ID. Therefore, it is respectfully submitted that Baker, Borgelt and Wells teach the limitations of claims 1 and 16, including "software information to be downloaded into said embedded system".

